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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WOLLSCHLAGER, JEFFREY MICHAEL

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/659,492

Applicant(s)

BULLOCK, RODDY MCKEE

Examiner

Jeff Wollschlager

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>61906</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The amendment to the claims filed June 19, 2006 has been entered. Claims 1-3 have been cancelled. Claim 4 is amended. Claims 5-10 are new. Claims 4-10 are pending. The Information Disclosure Statement filed June 19, 2006 has been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 5-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 5 and 6 cite Figure 6 for support. However, Figure 6 is directed to placement of pressure-sensitive adhesives in different locations on the surface of the file folder. It is not directed to different locations of the mechanically induced embossments produced from practicing the method of claim 4. There is no support in the specification for the claims as written.

Claims 7-9 recite the limitation “applying curable slip resistant material to at least a portion of said deformed places” (emphasis added). The instant disclosure states that light-tack adhesive may be disposed in the non-raised areas surrounding the bumps and that the raised bumps do not have adhesive on them (U.S. Patent Application Publication 2004/0053765, paragraph [0056]). There is no support in the specification for applying the light-tack adhesive to at least a portion of the deformed places.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite because amended claim 4 recites in the preamble that at least one of said flaps has a slip-resistant portion applied while the body of the claim requires both sides have the slip-resistant treatment. It is unclear what limitation is intended. Claim 4 recites the limitation “the paper stock”. There is insufficient antecedent basis for this limitation in the claim. The recitation is understood as “said folder paper stock”. Claim 4 further recites the limitation “said first and second deformed places”. There is insufficient antecedent basis for this limitation in the claim. A careful review of the claims is required to ensure consistency of terms throughout the claims. Appropriate correction, without the addition of new matter, is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4, 5 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Snowden (U.S. Patent 4,053,057; issued October 11, 1977).

Regarding claims 4 and 10, Snowden teaches a method of making a hanging file folder, said folder having a front flap having a first top edge, a rear flap connected to said front flap by a folder bottom, said rear flap having a second top edge, and a slip resistant portion disposed on both top edges comprising: providing folder paper stock; providing embossing/crimping/pressing dies in spaced operable, mating relationships; positioning said folder paper stock in said dies; applying force to at least one of said dies so as to decrease the spaced relationship; deforming said folder paper stock in first and second spaced apart places along the surface of said folder paper stock; attaching a bar along the top edges; folding said folder paper stock such that said first and second spaced apart places are located on the front and back exterior surfaces of the folder, so that the deformed folder paper stock in said first and second spaced apart places form gripping locations on the exterior surfaces of the folder (Figures 1 and 2, elements (24) and (26); Figures 5 and 6, elements (52) and (56); col. 3, lines 41-52; col. 5, lines 8-30).

As to claim 5, Snowden teaches that different systems may be installed on the front and back file folder. This will result in different portions of their respective surfaces

having different, asymmetrical deformations in the horizontal direction. (col. 5, lines 8-30).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Snowden (U.S. Patent 4,053,057; issued October 11, 1977).

As to claim 6, Snowden teaches the method of claims 4 and 5 as discussed in the 102(b) rejection above. Snowden further teaches the deformed portions are positioned horizontally across the exterior surfaces of the front and back top edges. Snowden does not expressly teach that the deformed portions are at different non-overlapping portions on their respective front and back surfaces. However, it would have clearly been within the skill of one having ordinary skill in the art at the time of the claimed invention to choose non-overlapping portions of the front and back surface deformations when practicing the method of making a file folder to facilitate closing and handling of the file folder. As such, the claim is rendered *prima facie* obvious in view of the prior art.

Response to Arguments

Applicant's arguments with respect to claim 4 have been considered but are moot in view of the new ground(s) of rejection. Applicant's amendment necessitated the new grounds of rejection.

Conclusion

All claims are rejected.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Wollschlager whose telephone number is 571-272-8937. The examiner can normally be reached on Monday - Thursday 7:00 - 4:45, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JW

Jeff Wollschlager
Examiner
Art Unit 1732

July 10, 2006

u f
CHRISTINA JOHNSON
PRIMARY EXAMINER
7/14/06